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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/575,623

07/13/2006

Niels Raeder

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EXAMINER

GUMBS, KEEGAN ROSS

ART UNIT

PAPER NUMBER

4128

MAIL DATE

DELIVERY MODE

02/19/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/575,623	<b>Applicant(s)</b> RAEDER, NIELS	
	<b>Examiner</b> KEEGAN GUMBS	<b>Art Unit</b> 4128	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/14/2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because legal phraseology such as "The invention relates..." should be avoided. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what structural limitation applicant intends to cover when claims 5 and 6 call for "the part". The writing instrument, as disclosed in the instant specification, is made of multiple parts so to reference "the part" is confusing. Since the metes and bound of the claimed subject matter could not be ascertained, the claims are indefinite. To expedite examination the examiner has interpreted "the part" to be referencing the information support.

4. Claim 1 recites the limitation "the information" in line 8. There is insufficient antecedent basis for this limitation in the claim, and therefore render the claims indefinite. Claims 2-12 depend from claim 1 and are likewise indefinite.

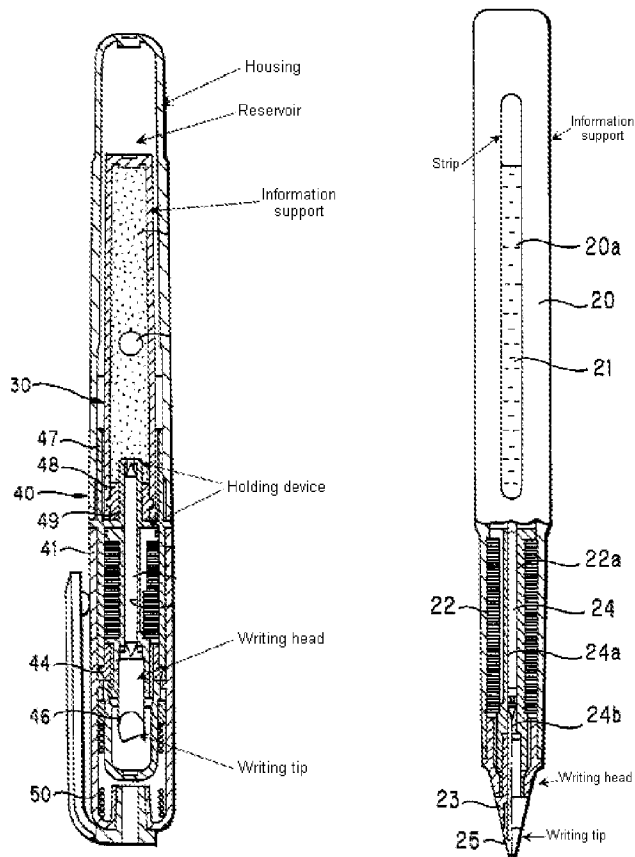
**Claim Rejections - 35 USC § 102**

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7 (*as presently and best understood*) are rejected under 35 U.S.C. 102(b) as being anticipated by Koyama (US 2001/0016142 A1).



Regarding claim 1, Koyama discloses a writing instrument comprising a housing with a reservoir, and a writing head with a writing tip (*see the annotated figures above*). Koyama further discloses an information support arranged in the reservoir where the ink

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hides information and the information becomes visible as ink is used (*see paragraph 0004 and the right annotated figure above*).

Regarding claim 2, Koyama discloses that the housing is made of a transparent plastic material (*see paragraph 0053*).

Regarding claim 3, Koyama discloses that the housing comprises a window gradually reveals a view of the information support as the ink is consumed (*see paragraph 0055*).

Regarding claim 4, Koyama discloses that the information support has the form of a part and in is held in the reservoir with the help of holding devices (*see paragraph 0049 and the annotated figures above*).

Regarding claim 5, Koyama discloses that the information support is made of plastic (*see paragraph 0045 and 0060*).

Regarding claim 6, Koyama discloses that information support has the shape of a disk or strip (*see the right annotated figure above*).

Regarding claim 7, Koyama discloses a writing instrument where it is inherent that the writing instrument is disposable. Koyama further discloses that the writing instrument could be a roller ball pen (*see paragraph 0017*).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-12 (*as presently understood*) are rejected under 35 U.S.C. 103(a) as being unpatentable over Koyama, as discussed supra, in view of Smith (US 6,068,422).

Regarding claims 8-11, Koyama discloses a writing instrument including an information support. Koyama does not disclose the information support including a paper or film underlay imprinted on or fixed to the information support, nor the information characterized in an image, an advertising text, an inscription, a lot number or the like. Attention is directed to Smith which discloses a transparent plastic film information support including information imprinted on the transparent plastic film information support (*see col. 1 lines 35-67*). The information characterized in measurement indicia (*see col. 1 line 43 and lines 57-60*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the writing instrument of Koyama to include a transparent plastic film information support further including information, characterized in measurement indicia, imprinted on the transparent plastic film information support in view of the teaching of Smith. Such a modification would allow the user to find out the amount of ink remaining in the pen.

Regarding claim 12, it also would have been obvious matter of design choice to modify Koyama by having the color of the information and/or of the information support coordinate with the coloring of the ink, since the applicant has not disclosed that having the color of the information and/or of the information support coordinate with the coloring of the ink solves any stated problem or is for any particular purpose.

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***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burden et al. (US 6,742,953 B2), Brummernhenrich (US 6,386,780 B1), Kirklen (US 3,343,293), Kirklen (US 3,315,395), Parker (US 2,971,283), Herne (US 2,896,348), Wilson (US 2,347,144), Wuestman (US 2,304,522), Echevarria (US 1,372,608), and Ogilvy (1,317,817) all disclose writing instruments with transparent walls that for display or information purposes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEEGAN GUMBS whose telephone number is (571)270-5608. The examiner can normally be reached on Monday through Friday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoa Huynh can be reached on 5712724888. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KRG  
AU 4128

/Khoa D. Huynh/  
Supervisory Patent Examiner, Art Unit 4128